1731

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

VUORINEN et al

Serial No. **08/925,321**

Filed: **September 8, 1997**

Atty. Ref.: **30-336**

Group: **1731**

Examiner: **Alvo**

#26

For: **METHOD OF TREATING CELLULOSIC PULP**

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December 10, 1999

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

PETITION FOR REVIEW OF THE PROPRIETY OF THE SECOND NOTIFICATION OF NON-COMPLIANCE ISSUED DECEMBER 1, 1999

This is a petition for the review of the propriety of the issuance of the Notification of Non-Compliance of December 1, 1999. It is not believed that any fee is due for this petition, but if one is in fact due the Patent & Trademark Office may charge Account No. 14-1140, Our Order No. 30-450. Since the Examiner refused to treat the paper filed August 23, 1999 as a petition, now this paper is specifically being filed as a petition and it is requested that it be decided by someone other than the Examiner so that the prosecution of the case can be advanced.

37 CFR 1.192(c)(7) provides "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." In this case, under no stretch of the imagination have appellants violated that provision. Appellants have not only pointed out that the features in the claims are not shown in the references but have specifically provided (see the last sentence in the second and third paragraphs on page 20 of the Brief) that with respect to all of the claims involved in each situation "nor is there any reason why one of ordinary skill in the art would employ what is

specifically called for therein (or any *prima facie* case established in the Final Rejection)". That is, it is also argued that not only is what is set forth in all of the claims not shown in the prior art, but that there is no reason why one of ordinary skill in the art would employ what is set forth therein, and therefore no *prima facie* case of obviousness. The Federal Circuit and CCPA before it have clearly and unequivocally required the Patent & Trademark Office in the first instance to establish a *prima facie* case of obviousness. See *In re Warner*, 154 USPQ 173, 177-78 (CCPA 1967).

In determining the propriety of a rejection under 35 USC §103, it is well settled that the obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598, 1599 (Fed. Cir. 1988); *Ashland Oil, Inc. v Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed.Cir. 1984). The law of the Federal Circuit is that "[a] *prima facie* case of obviousness is established <u>when</u> the teachings from the <u>prior art itself</u> would appear to have <u>suggested</u> the claimed subject matter to a person or ordinary skill in the art." *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976), emphasis added. See also *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("In determining whether a case of *prima facie* obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to <u>suggest</u> making the claimed substitution or other modification." (emphasis added).

Appellants arguments pointing out that the Patent & Trademark Office has completely failed in establishing a *prima facie* case of obviousness with respect to the claims is entirely appropriate argument, and it is for the Board of Appeals to determine whether or not that will result in reversal of the Final Rejection, not the province of the Examiner writing the Final Rejection to deny appellants the right to have that consideration.

The consideration of appellants' arguments should also be specifically evaluated in the context of the Final Rejection. While criticizing appellants for not specifically arguing each individual claim, the Final Rejection does not even mention the claims at issue here. Reading the Notification of Non-Compliance one would expect that the Final Rejection contained detailed rejections of claims 13, 15, 21, 3, 18, 20, and 22 through 28. However, upon inspection of the Final Rejection one sees that only claims 3, 20, and 21 are even mentioned. The other claims are completely and unequivocally ignored. Apparently what the Notification of Non-Compliance wants is for appellants to argue against themselves, or to assume what the reasoning is for the rejections of the individual claims in the shotgun rejection provided in the Final Action, and then argue against that assumption. There is no basis in the Rules of Practice, the statute, or the MPEP for that approach, and it is completely inappropriate to expect appellants to do any more than they have (which completely fulfills the requirements of 37 CFR 1.192) under these circumstances.

With respect to the allegation that claims 3, 18, 20 and 27 have been argued as a "single group" and there is no argument "as to why the claims are separately patentable", these claims are entirely distinct claims, with different limitations, and

claims 18, 20, and 27 were argued earlier (than on page 18 -- namely see, for example, page 17, including footnote 2), and therefore they are patentably distinct from each other. Again, 37 CFR 1.192 does not require appellants to argue against themselves, to assume positions in the Final Rejection that are not there, or to supply for the Patent & Trademark Office the items missing from the Final Rejection in establishing a *prima facie* case of obviousness.

Early withdrawal of the Notification of Non-Compliance and early reversal of the Final Rejection are respectfully requested.

Respectfully submitted,

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